

REMARKS

In view of the above amendments and discussions to follow, Applicants submit that Claims 1-9 which are in the application are patentably distinct over the prior art. Claims 1-9 are rejected under 35 USC 102(a) and/or (b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Weber '043 B1, Mann '964, or Carduck et al. '124, and further under 35 USC 112, second paragraph as being indefinite.

More specifically, the claims are unanticipated by the references, since the references fail to recite all the elements of the claimed building material as summarized below. The record, thus far, lacks a factual or technical basis for a conclusion that the elements of the claimed building materials are substantially the same as disclosed by the references, or that the skilled artisan would have envisaged the claimed invention from the cited references.

The patentable distinction is argued more fully hereunder by presenting a summary of the invention, a statement of the rejections, and how they are avoided or overcome.

Summary of the Invention

In accordance with the present invention, there is provided a building material composition prepared from or having added thereto a particulate material selected from the group consisting of particulate polysaccharides and particulate polysaccharide derivatives, wherein the particulate material is prepared by a method comprising:

- (a) forming a feed composition comprising a member selected from the group consisting of polysaccharides and polysaccharide derivatives, and 35 wt. % to 99 wt. % of water, based on the total weight of the feed composition, wherein said member is at least one of swelled and dissolved in the feed composition;
- (b) contacting, in a mill, the feed composition with a gas stream, thereby converting simultaneously the water of said feed composition into water

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vapor, and said member of said feed composition into a solid state form of finely particulate material;

- (c) separating the particulate material from the gas stream; and
- (d) optionally drying the particulate material.

It is a distinct feature of the invention that, building materials containing the polysaccharides or polysaccharide derivatives in accordance with the invention, exhibit marked improvement in performance. Illustratively, as renders, they exhibit an improved water retention capacity in comparison with conventionally produced methylhydroxyethylcellulose ethers, especially under particularly critical conditions (for example, at 40°C). As adhesives, particularly tile adhesives, they exhibit improved tensile bond strengths and/or more rapid onset of cure of the adhesive. As cement extrusions prepared from particulate polysaccharides or polysaccharide derivatives, they exhibit plasticisation and dimensional stability together with reduced cracking of the extruded mouldings.

The cited references fail to teach or suggest building materials comprising polysaccharides as characterized above.

Statement of the Examiner's Basis for the Rejection

The art rejections are based on the grounds that:

"All of the above cited references would appear to teach a building material comprising polysaccharide and containing components in the amounts overlapping the claimed invention thus anticipating the instant invention. Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art."

The indefinites rejection is based on the grounds that:

"The terms 'polysaccharide derivative' would appear indefinite and it is unclear how it is different than polysaccharides."

Further, the claims stand rejected on the grounds that the term "selected from" in Claims 2-6 is indefinite and should be amended to "selected from the group consisting of".

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Statement of How Applicants Avoid or Overcome the Rejection

Properly construed, the claimed invention relates to building materials which are produced by harnessing the claim elements as to their nature, and amount, and under conditions which result in materials of improved properties. The claims, and for that matter the materials of the claims, are different from those of the references.

Hence, there is presented an issue of whether the cited references teach the same invention as recited by the claims, or whether the skilled artisan would have envisaged the claimed invention from the references.

It is well settled in the law that for a reference to anticipate a claim, it must teach all the elements of the claims, *Verdegaal Bros. v Union Oil Co. of California*, 2USPQ2d 1051 (Fed. Cir. 1987). Applicants respectfully submit that the references do not teach all the elements of the claims. In this case, the record is devoid of any evidence that the process, polysaccharides or the building materials are substantially identical. And no rational is provided for such substantial identity.

To the contrary, the record shows that building materials have improved properties over the referenced materials. Thus, when the building material implied by the process is considered in assessing patentability of claims, one would conclude that the products of the claims would be patentably distinct, *In re Gamero*, 223 (CCPA 1979).

It is also well settled in the law that for an asserted overlap to render claims anticipated, said overlap must be such that the skilled artisan would have necessarily envisaged the claimed invention from the cited references. In this case, the record does not speak to the nature of the overlap. Moreover, the record does not support the assertion that the skilled artisan would have envisaged the polysaccharides as to type, proportions or conditions for producing them and for that matter the building materials. The references are further discussed and distinguished below.

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Weber et al. is directed to a process for the production of finely divided cellulose ether particles by treating the cellulose ether with superheated water vapor in a mill.

Carduck et al. discloses cellulose ethers as micropowders, produced in a conventional manner in a mill. The cellulose ethers are not treated according to our invention as described in steps a) to d) in Claim 1.

Weber et al. and Carduck et al. do not disclose that cellulose ethers prepared as described in Claim 1 exhibit an improved water retention capacity and a better dimensional stability when used in building material compositions in comparison with conventionally produced cellulose ethers (application, p. 4 and examples).

Mann (US 5,749,964) discloses cellulose ethers which have been treated with a hydrophobicizing agent. The cellulose ethers according to our invention are not treated with such hydrophobicizing agent.

From the foregoing, the Examiner would agree that the references do not teach the invention wherein the cellulose ethers are produced as described in step a) to d) to provide a building material having an improved water retention and better dimensional stability when used in building material compositions. As such, the claimed invention is novel and unanticipated.

Heretofore, to impart improvements, the art resorted to methods which were described in the cited references, e.g., Mann, which provides for adding hydrophobicizing agent, or Carduck, which provides for using micropowders, and the like.

In contrast, Applicants have employed process steps which harness the polysaccharides as to the type, amount and reaction conditions to produce building materials of improved properties. Given their improved properties, one would be hard pressed to argue that materials of the claims and the references are the same,

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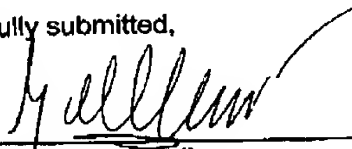
or that the former can be envisaged from the latter. As such, the claims are not anticipated by the references. Therefore, Applicants pray for the withdrawal of the rejection based on the cited references.

Returning to the 35 USC 112, second paragraph rejections, the above amendments address this rejection with exception of the rejection of the claims as being indefinite for reciting the term "polysaccharide derivative". Applicants traverse this rejection because the skilled artisan would readily ascertain the metes and bounds of claims reciting the term. Moreover, the term "polysaccharide derivative" is described and illustrated by the specification, particularly in last paragraph of page 7. It is well established that if the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and the scope of the invention, and if the language is as precise as the subject matter permits, the requirements of 35 USC 112, second paragraph are met, Shatterproof Glass Corp. v Libbey Owens Ford Co. 225 USPQ 634 (Fed. Cir. 1985). Applicants are nonetheless amenable to suggestion of terms which would be acceptable to the Examiner.

Net: In view of the foregoing amendments and discussions, Applicants submit that the claims in the application are patentably distinct and are in a condition for allowance. Applicants, therefore, pray for their allowance.

Respectfully submitted,

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